

REMARKS

Claims 1-15, 17-25, 30-34 and 37-45 are all the claims presently pending in the application. Applicants have amended claims 1, 40, and 42 to define the claimed invention more particularly. Applicants have added new claims 43-45. No new matter is added.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 40, and 42 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

This rejection is respectfully traversed in view of the following discussion.

I. 35 U.S.C. 112, SECOND PARAGRAPH REJECTION

In rejecting claims 1, 40, and 42, the Examiner alleges that the claims are indefinite for failing to particularly point out the invention.

Specifically, the Examiner alleges that the claim limitation, “*wherein said plurality of magnetic layers includes a perpendicular magnetic anisotropy component, H_p , with a magnitude sufficient to at least substantially offset an easy-plane demagnetization effect $4\pi M_s$, where M_s is a saturation magnetization, such that said perpendicular magnetic anisotropy component, H_p , reduces an amount of spin current needed to rotate said magnetic moment of said free magnetic layer out of the film plane,*” (emphasis added by Applicant) as recited in claim 1, and similarly recited in claims 40 and 42, recites a means-plus-function limitation without disclosing clearly corresponding structure in the specification. The Examiner, however, is clearly incorrect.

Applicants respectfully submit that the claim limitation clearly describes structural limitations and does not include a means-plus-function language.

That is, MPEP clearly states that “*A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:*

- (A) *the claim limitations must use the phrase "means for" or "step for;"*
- (B) *the "means for" or "step for" must be modified by functional language; and*
- (C) *the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function," and "examiners should apply the 3-prong*

analysis to determine whether the claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph. A claim element that does not include the phrase "means for" or "step for" will not be considered to invoke 35 U.S.C. 112, sixth paragraph" (see MPEP 2181 (I)).

Accordingly, since claims 1, 40, and 42 fail to meet the following 3-prong, the Examiner's rejection is improper.

Moreover, even assuming *arguendo* that the claimed limitation recites a means-plus-function language, the specification of the present Application clearly describes the claimed invention and fully complies with 35 U.S.C. 112, second paragraph.

The Examiner is referred to Figs. 2A and 2B and page 12, line 23 – page 13, line 5 of the present application which disclose an exemplary embodiment of the present application, in which “*The magnetic layers of the spin-current switched magnetic memory element may include composite layers which may include, for example, a magnetic layer and a non-magnetic metal layer (e.g., cobalt and gold composite layers, cobalt and platinum composite layers, etc.). In such a composite layer, a perpendicular magnetic anisotropy component may be provided at an interface between layers (e.g., between a magnetic layer and a non-magnetic layer) in the composite magnetic layers. For example, FIGS. 2A-2B illustrate a spin-current switched magnetic memory element 200 having composite magnetic layers 121, 122*” (e.g., see Application at page 12, line 23 – page 13, line 5).

Indeed, MPEP states that “*The following guidance is provided to determine whether applicant has complied with the requirements of 35 U.S.C. 112, second paragraph, when 35 U.S.C. 112, sixth paragraph, is invoked*:

(A) If the corresponding structure, material or acts are described in the specification in specific terms (e.g., an emitter-coupled voltage comparator) and one skilled in the art could identify the structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs and are satisfied. See Atmel, 198 F.3d at 1382, 53 USPQ2d 1231...

(1) If one skilled in the art would be able to identify the structure, material or acts from the description in the specification for performing the recited function, then the requirements of 35 U.S.C. 112, second paragraph, are satisfied. See Dossel, 115 F.3d at 946-47, 42 USPQ2d at 1885” (see MPEP 2181 (III)).

Accordingly, the specification of the present Application clearly describes the claimed invention and fully complies with 35 U.S.C. 112, second paragraph.

Thus, the specification of the present Application clearly describes corresponding structure to the aforementioned claim limitation.

Moreover, Applicants have amended claims 1, 40, and 42 to recite, "*wherein said perpendicular magnetic anisotropy component, Hp, comprises one of:*

an interface-induced perpendicular magnetic anisotropy component which originated at an interface within a multilayer structure in the free magnetic layer;

a strain-induced perpendicular magnetic anisotropy component which originated within at least one of the fixed magnetic layer and free magnetic layer; and

a crystalline anisotropy-induced perpendicular anisotropy component which originated within at least one of the fixed magnetic layer and free magnetic layer," for clarity.

Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

II. NEW CLAIMS

New claims 43-45 have been added to claim additional features of the invention and to provide more varied protection for the claimed invention. The claims are independently patentable because of the novel features recited therein.

Applicants submit that new claims 43-45 are patentable at least because of similar reasons to those set forth above with respect to claims 1-15, 17-25, 30-34 and 37-42.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicants submit that claims 1-15, 17-25, 30-34, and 37-45, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Farhad Shir

Date: 03/23/09

Farhad Shir, Ph.D.
Registration No. 59,403

Sean M. McGinn, Esq.
Registration No. 34,386

McGinn IP Law Group, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer No. 21254